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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Eldon H. Nyhart, Jr.

Application No. : 10/045,550

Confirmation No. 3390

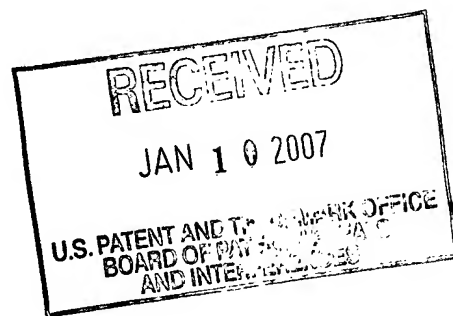
Filed : October 26, 2001

Title : MANUFACTURING METHODS FOR AN
APPARATUS FOR THE CONTROLLABLE
MODIFICATION OF COMPOUND
CONCENTRATION IN A TUBE

Group/Art Unit 3763

Examiner : Loan H. Thanh

Docket No. : BIO-P001-02
(previously 41594-200407)



MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the Final Rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

Review is requested for the reasons stated on the attached two (2) sheets.

Remarks

In an Office Action dated February 27, 2006, the Examiner rejected the independent claim, namely claim 57 as being anticipated by Altman et al. (US 6,086,582).

Applicant submitted a response on August 24, 2006 discussing some of the reasons why the Altman reference was not an anticipatory reference. The Examiner issued a Final Rejection dated November 3, 2006 and maintained the rejection of independent claim 57 as being anticipated by the Altman reference.

After considering the Examiner's rebuttal to Applicant's arguments, Applicant submits that a prima facie case of anticipation has not been made by the Examiner. "For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art." *Motorola, Inc. v. Interdigital Technology Corp.*, 121 F.3d 1461, 1473, 43 U.S.P.Q.2d 1481, 1490 (Fed. Cir. 1997) (*citing In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)).

Claim 57

Independent claim 57 is directed to a method for providing a compound to a system. Claim 1 requires, in part, "preparing a control signal using fractal mathematics" and "operating the controller with the control signal." The final Official Action admits that such a control signal is not expressly taught by the reference. However, the Official Action takes the position that such a feature is inherent in the Altman reference. As grounds for doing so, the Official Action states "the computer/controller is inherently producing fractal mathematics since fractals are generated by an iterative process – doing the same thing again and again. The computer/controller has this factor built in." In order for something to be inherent, it must necessarily be present. Many things are produced by an iterative process. Showing that a computer has an iterative process does not teach, necessitate, or inherently include that fractal mathematics are thereby utilized. Additionally, the Official Action states that "[f]ractals also have the property that when you magnify them they still look much the same. The device of Altman produces the same control signal to release the compound." Applicant fails to understand the relevance of this statement. Assuming that the statement is true, showing that a provided signal has a characteristic in common with a fractal based signal does not teach, suggest, necessitate, or inherently require a fractal based signal.


Accordingly, the Official Action fails to cite a reference that expressly teaches a control signal utilizing fractal mathematics, and the arguments for the inherency of such a feature fail to show that the fractal mathematics are necessarily present. For at least the above reasons, Applicant believes that claim 57 and claims 58-65 and 104-106 which depend from claim 57 are believed to be in condition for allowance. Such allowance is respectfully requested.

Conclusion

Applicants believe that that the rejection of claims 57-65 and 104-106 under 35 U.S.C. §102(e), **must be reversed** as the Examiner has failed to make a *prima facie* case of anticipation. As mentioned above, limitations are missing from the Altman reference.

Most notably, Altman fails to teach, expressly or inherently, a control signal using fractal mathematics.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 3, 2007.



D. Cwiklinski